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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,364	10/25/2001	Clive P. Hohberger	7887/83889	3268

7590                    11/20/2002

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EXAMINER

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ART UNIT                  PAPER NUMBER

2853

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/001,364	HOHBERGER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	An H. Do	2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 October 2001.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-172 is/are pending in the application.
- 4a) Of the above claim(s) 14-140 and 153-172 is/are withdrawn from consideration.
- 5) Claim(s) 7-13 is/are allowed.
- 6) Claim(s) 1-3,5,6 and 141-152 is/are rejected.
- 7) Claim(s) 4 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                           | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This is the first Office Action on the merits responsive to the filing of the pending application, which is a CON of US 09/969,114 filed on 01 October 2001.

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 25 October 2001 was filed and is being considered by the examiner.

### ***Specification***

2. The abstract of the disclosure is objected to because of the following:
  - Delete "A media printer such as, for example," in the first line of the paragraph.
  - Change "a thermal" in the first line of the paragraph to --A thermal--.
  - Delete "value-adding elements such as" in lines 7 and 8.Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

3. Claims 2, 8, 142, 143 and 148 are objected to because of the following informalities:

#### **In claim 2:**

-Change "devices comprise" in line 1 to --device comprises-- to correct some minor antecedent basis.

#### **In claims 8 and 142:**

-Delete "adopted" in line 2 and replace with --used-- to correct some minor syntax errors.

In claims 143 and 148:

-Delete "other wireless or" in line 2 to correct some minor syntax errors.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 145 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "...wherein said communicating step comprises..." and depends on previous apparatus claim 143, which "...comprising means for communicating with said transponder." It is vague and unclear whether the applicant hereby tries to claim the method or the apparatus. From the examiner's point of view, claim 145 should be amended to address the apparatus feature(s) rather than the method step(s).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United

Art Unit: 2853

States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-3, 5, 6, 141-152 are rejected under 35 U.S.C. 102(e) as being anticipated by Pou (US 6,188,423).

Pou discloses in Figures 1 and 2 an on-demand printer (20) for printing (22) information on a series of labels, tickets, tags, cards or other media, comprising: a media feeder, and means for associating a discrete value-adding element (232) with certain media, but not with other media, in a series of said media, wherein said value-adding device (232) comprises a radio frequency identification (RFID) transponder or other wireless transponder (column 2, lines 26-28). Pou further discloses means for determining whether said radio frequency identification transponders are defective or misprogrammed (column 2, lines 29-38), further comprising means for communicating (25) with said transponder, means (26) for reading information stored in the transponder, or writing information into the transponder, further comprising means for processing (24) said media before said value-adding element is associated with said selected media, wherein said printing apparatus is responsive to said means for communicating and prints an indication of a defect or another characteristic or attribute of said transponder (column 2, lines 32-38), and wherein said means for associating is controlled by a computer- program (column 2, lines 14-17).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Austin et al (US 5,781,708) discloses an integral bar code printer (100) having optional peripheral interface (110) and transceiver (126) to communicate with the host computer (104). Eade et al (US 6,092,888) discloses an inkjet printer

(100) includes a processor (104) which coupled to the host computer (102) using wireless techniques such as infrared communication.

***Allowable Subject Matter***

9. Claims 7-13 are allowed.

10. The primary reason for the allowance of claim 7 is the inclusion of the limitations of an applicator mechanism that is mounted in operative relation to said generally continuous web to attach a value-adding device to a second surface of selected ones of said media samples after information has been printed on the first surface of said selected ones of said media samples by said printhead. It is these limitations found in each of the claims, as they are claimed in the combination, that has not been found, taught or suggested by the prior art of record which makes these claims allowable over the prior art.

11. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: means for causing a failure indicia to be printed on a surface of each one of said media samples to which a defective or misprogrammed radio frequency identification transponder is attached.

***Contact Information***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An Do whose telephone number is (703) 308-0525. The examiner can normally be reached from Monday - Friday.

If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow Jr., Art Unit 2853, can be reached on (703) 308-3126. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
AD  
November 16, 2002

  
RAQUEL GORDON  
PRIMARY EXAMINER